

REMARKS

Applicant respectfully requests reconsideration of the application in view of the following remarks and the Amendment to Correct Inventorship, Declaration under 35 U.S.C. § 1.132, and Terminal Disclaimer submitted herewith.

Status of Claims

The claims presented in the forgoing listing of claims reflects the claims as amended by the Examiner's Amendment contained in the Notice of Allowance mailed July 25, 2008. Claims 39 and 43-48 remain pending and are not further amended. These claims are presented for reconsideration.

Correction of Inventorship

Applicant submits herewith an Amendment to Correct Inventorship under 37 C.F.R. § 1.48(b), to remove Philippe Rouanet as an inventor. This correction stems from the Restriction Requirement which resulted in the invention to which Philippe Rouanet contributed not being examined in this application.

§102 Rejections

Claims 39, 43-48 were rejected under §102 (e) as allegedly anticipated by Bua (US 2004/0138214) and de Lignieres et al. (US 2005/0032909). Applicant respectfully traverses.

Both Bua and de Lignieres were cited for teaching compositions for percutaneous administration that comprise 4-OHT, isopropyl myristate, ethyl alcohol, hydroxypropylcellulose and phosphate buffer, in amounts that fall within the scope of the pending claims. *See, e.g.*, Office Action, pages 2-3. The references also are cited for teaching that 4-OHT is packaged in a dose-meter pump, allegedly anticipating claim 48. *See, e.g.*, Office Action, page 3.

Without acquiescing to the merits of the rejections, Applicant submits herewith a Declaration under 35 U.S.C. § 1.132 by inventors Dominique Salin Drouin and Jacques Wepierre, attesting that “the 4-hydroxy tamoxifen compositions within the scope of the pending claims that are disclosed in U.S. Patent Publication No. 200/0138214 or U.S. Patent Publication No. 2005/0032909 were derived from the inventors of the captioned application and were not invented by the inventive entity of Bua or de Lignieres.” Declaration, ¶¶ 3, 5.

As set forth in MPEP § 715.01(a), 716.10 and 2136.05, this Declaration effectively removes Bua and de Lignieres as prior art references against the instant application. Accordingly, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Obviousness-Type Double Patenting Rejections

The Office Action provisionally rejects the claims under the doctrine of obviousness-type double patenting over five co-pending applications: (i) US 10/734,644; (ii) US 11/009,390; (iii) US 10/805,528; (iv) US 10/734,640 and (v) US 11/249,122.

Without acquiescing to the merits of these rejections, Applicant submits herewith a Terminal Disclaimer over applications (i) US 10/734,644; (iii) US 10/805,528 (now US 7,507,769); and (iv) US 10/734,640. Thus, the rejections over these applications are overcome.

Applicant respectfully requests that provisional rejections over co-pending applications (ii) US 11/009,390 and (v) 11/249,122 be deferred until this application is otherwise in condition for allowance. Moreover, should this be the only issue remaining, the provisional obviousness-type double patenting rejections should be withdrawn in this application and imposed or retained in the ‘390 and/or ‘122 applications, if appropriate. This is because this application has an earlier effective U.S. filing date than applications (ii) US 11/009,390 and (v) 11/249,122. *See* MPEP § 804(I)(B)(1) (“If a ‘provisional’ non-statutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on

other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.”).

REQUEST FOR INTERVIEW

Applicant believes that the application is in condition for allowance, and an early notice to that effect is earnestly solicited. Should the Examiner find otherwise, Applicant respectfully requests that, prior to issuance of a further Office Action, the Examiner contact the undersigned by telephone in order to arrange an Interview to expedite prosecution.

The Commissioner is hereby authorized to charge any additional fees, which may be required regarding this application under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, Applicant hereby petitions for such extension under 37 CFR §1.136 and authorizes payment of the related fee(s) from the deposit account.

Respectfully submitted,

Date July 1, 2009

By Courtenay C. Brinckerhoff

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4094
Facsimile: (202) 672-5399

Courtenay C. Brinckerhoff
Attorney for Applicant
Registration No. 37,288